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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,651	05/10/2002	Yves Hervet	28944/37583	4663
4743	7590	09/21/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			LAO, SUE X	
			ART UNIT	PAPER NUMBER
			2194	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/030,651	HERVET ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sue Lao	2194	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*he*

*[Signature]*

### DETAILED ACTION

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-20 are presented for examination.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of independent claim 1 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claim 1 does not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention comprised of software alone. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine

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constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998). MPEP 2106. State Street required transformation of data by a machine before it applied the "useful, concrete, and tangible test." However, State Street does not hold that a "useful, concrete and tangible result" alone, without a machine, is sufficient for statutory subject matter. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention appears to be comprised of software alone without claiming associated computer hardware required for execution.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a number of limitations which lack sufficient antecedent basis in the claim. For example, line 6, "the control interface"; line 7, "the assembly"; line 12, "the application".

Claim 1 also recites a number of confusing/conflicting limitations. For example, the inconsistent use of terms "interactive application" (line 1), "the application" (line 12) and "said application" (line 16) does not define whether these limitations are the same and/or related in some manner. It is also not clear whether the "thematic scenes" (line 3) and "constituent scene" (line 15) are the same/related. Further, it is not clear whether the "system" (line 1), the assembly (line 7) and the "execution platform" (line 9) refer to the same entity.

Furthermore, claim 1 recites "defined as an initiation respectively a modification of at least one of the display" in line 19, which is confusing/conflicting. It is noted that claim 2, lines 8-9 appear to recite corresponding/similar limitations.

Regarding claims 5 and 12, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

For the purpose of art rejection, these indefinite limitations are interpreted as best understood and as they appear to be.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vazirgiannis et al ("I-Mu.S.E. – Interactive Multimedia Scenario Editor") in view of Bloem et al (WO 99/04349).

As to claim 1, Vazirgiannis teaches a system for developing interactive applications (IMAP, sections 1, 2) distributed on a digital transmission channel, these interactive applications installed at a point of the digital transmission network (interactive TV, digital movies, section 1) consisting of a succession of thematic scenes (MAP scenario) incorporating at least images in point mode, video images, sound sequences and information in text file form (digital movies) represented at the level of at least one display monitor (fig. 2), the interactive nature of these applications being produced by way of a specific functionalization (event specification, scenario specification) of the control interface for a control module (media objects) of the display monitor furnished with an operating system, the assembly consisting of the display monitor (fig.s 2-7),

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control module (inherent to Vazirginnis) and operating system (inherent to / obvious to the system of Vazirginnis) constituting an execution platform, this system comprising at least one electronic editor (authoring environment, section 3) and means generating virtual objects (media objects, scenario tuples), specific to the application considered, each virtual object consisting of components chosen from among at least images in point mode, video images, sound sequences and information in the form of text files being capable of being edited, displayed and represented by said electronic editor (authoring environment) so as to form at least one constituent scene of said application, wherein it furthermore comprises:

control means for correlating (IMAP script) a plurality of event/action pairs (event due to action, section 2.2), an event being defined as the breakage of state equilibrium of said operating system and an action being defined as an initialization respectively a modification of at least one of the display and representation parameters for one or more constituent scenes of said application (state change event, section 4.1);

means for storing (storage, fig. 8) the set of event/action pairs, correlated and constituting said interactive application.

Vazirgiannis does not teach allowing the simulation, on the one hand, of the display screen of said display monitor, and, on the other hand, of the control interface for a control module associated with this display monitor.

Bloem teaches a system for developing interactive applications which allows simulation of a display screen of a display monitor and of a control interface for a control module associated with this display monitor (graphical components in target system, page 5, lines 15-25, fig. 2). Therefore, it would have been obvious to include the simulation, on the one hand, of the display screen of said display monitor, and, on the other hand, of the control interface for a control module associated with this display monitor, into Vazirgiannis. One of ordinary skill in the art would have been motivated to combine the teachings of Vazirgiannis and Bloem because this would have simplified customization for a variety of platforms with the underlying software libraries (page 2, lines 9-13).

As to claim 2, Vazirgiannis teaches event action correlations, including correlating a plurality of event/action pairs comprise means generating a series of instructions exhibiting a checking structure of list of requests type for "EVENT" IF condition on any Boolean variable Bi set of Boolean variables true THEN "ACTION" or "EVENT" designates a variable representative of an event and "ACTION" designates a variable representative of an action conditioned on the set of Boolean variables, said variable "EVENT" true constituting for each event/ action pair a breakage of state equilibrium of said operating system and said action constituting an initialization or a modification of at least one of the display and representation parameters for one or more constituent scenes of said application (events, actions, and their specifications, sections 2.2, 2.3, 3.2, 3.3).

As to claim 4, Vazirgiannis as modified teaches display monitor, said control module and said operating system being those of a television receiver, said electronic editor allows the simulation of the display screen of this television receiver and of the control interface for a universal remote control module associated with this television receiver, with a specific key of said simulated universal remote control module there being associated an event, causing the breakage of state equilibrium of said operating system (target systems including TV, page 5, lines 15-25, fig. 2).

As to claim 5, Vazirgiannis as modified teaches said display monitor, said control monitor and said operating system being those of a workstation or of a microcomputer (host PC, fig. 2, page 5, lines 15-25), said electronic editor allows the simulation of the display screen of this microcomputer and of the control interface for a peripheral input apparatus of this microcomputer, such as the keyboard, with a specific key of said peripheral input apparatus there being associated an event causing the breakage of state equilibrium (state change event, section 4.1) of said operating system.

As to claim 6, Vazirgiannis as modified teaches the set of event/action pairs is correlated according to a logic one-to-one mapping between event and action (Vazirgiannis, scenario model, section 2.3), according to a native interactive application (Bloem, target system), independently of the access format imposed by the system or

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platform for access to the interactive application considered (configurable, page 3, lines 21-24).

As to claim 7, Vazirgiannis as modified teaches said electronic editor, said means generating virtual objects specific to the application and said control means for correlating a plurality of event/action pairs comprise a driver software module making it possible, on the one hand, on the basis of a window for displaying a representation of said control module and of peripheral apparatuses, to receive a corresponding variable "EVENT" and, on the other hand, on the basis of a window for displaying constituent scenes of said application, to cause either their initialization or their modification (Vazirgiannis, events, actions, and their specifications, sections 2.2, 2.3, 3.2, 3.3) (Bloem, configurable components, page 3, lines 21-24).

As to claim 19, Vazirgiannis as modified teaches the set of data structures and macroinstructions constituting a native interactive application (components and interface implementations on host platform), a module for translating (authoring system) said native interactive application into an interactive application dedicated to a determined-type access terminal (components and interface implementations on the target platform, fig. 2).

9. Claims 3, 8-18, 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101 and 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims, subjected to a final search update.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (571) 272-3764. A voice mail service is also available at this number. The examiner's supervisor, SPE Meng-Ai An, can be reached on (571) 272 3756. The examiner can normally be



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reached on Monday - Friday, from 9AM to 5PM. The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sue Lao

September 16, 2005



**SUE LAO**  
**PRIMARY EXAMINER**